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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,506	10/02/2006	David Walterus Cornelius Dekkers	DEKK3001/REF	9893
23364 7590 03/18/2009 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER KUMAR, SHAILENDRA				
ART UNIT		PAPER NUMBER		
1621				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,506

Applicant(s)

DEKKERS ET AL.

Examiner

SHAILENDRA -. KUMAR

Art Unit

1621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 1/23/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-20 are pending in this application.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 1/23/06 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

3. The drawings were received on 1/23/06. These drawings are acceptable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, and 5-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines R2 in terms of "more preferably" and R4 in terms of "preferably". In doing so, the claims are rendered indefinite.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-16 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. A number of factors are relevant to whether undue experimentation would be required to practice the claimed invention, including “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988).

(1). Breadth of Claims: Claims 14-16 and 20 are directed to a method of treatment or prevention of various diseases including neoplastic viral and autoimmune diseases by administering to a host in need of such treatment a therapeutically effective amount of a compound of claim 1. This contemplates Alzheimer's and AIDS.

Scope of Compounds - The scope of the compounds is broad. It is apparent that hundreds of combinations of compounds can be created from the definitions, owing especially to broad scope of R1_R4, X and T1.

- (2). Direction of Guidance: The amount of direction or guidance is minimal. No data on any specific compound is given. No dosage guidance is provided.
- (3). State of Prior Art: There is no evidence of record that compounds structurally similar to these malonamide compounds are in use for the treatment of Various diseases as reported on pages 12-13 of the instant specification.
- (4). Working Examples: There is no any working example that indicates that effects of Interleukin can in return is presumed to treat or prevent so many diseases as contemplated on pages 12-13 of the instant specification, or for that matter, it can be combined with any food for the edible purposes. There is no biological data for any of the compounds.
- (5). Nature of the Invention and Predictability: The invention is directed to treating and preventing various diseases as specified on pages 12-13 of the instant specification and to fortify food with the claimed compound 1. It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved," and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

(6). The Relative Skill of Those in the Art: Applicants claim a method of treatment or prevention for numerous diseases specified on pages 12-13 of the instant specification, and also to the fortified food with the claimed compound. The diseases contemplate Alzheimer's' and HIV, which are very hard to treat diseases. The central characteristic of Alzheimer's disease is the deficiency in the level of the neurotransmitter Acetylcholine that plays an important role in memory. Alzheimer's disease is an extraordinarily difficult disease to treat, and has been the subject of a vast amount of research. Despite an enormous number of different approaches, the skill level in the art is so low relative to the difficulty of task that the only success has come from treatment by compounds which are Acetylcholinesterase inhibitors (Aricept®, Cognex®, Exelon®, and Reminyl®) a property these compounds are not disclosed to have.

(7). The Quantity of Experimentation Necessary: Immense, especially in view of point 6, since there is nothing in the record that suggest that interleukin production is correlated with the various diseases as specified on pages 12-13 of the instant specification. Thus, no guidance from the success of others is available from this experimentation.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*,

999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” That conclusion is clearly justified here.

7. Claims 17-18 provides for the use of compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 17-18 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 7-10 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Vennerstrom et al(J. Med. Chem., 1987)

Vennerstrom et al, Table I, page 436, anticipate instant claimed compounds, especially, when R, X, Y and Z can be similar to those claimed compounds.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-4, 7-10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vennerstrom et al.

Vennerstrom et al teach structurally similar compounds as claimed in herein. See table I, on page 436. The difference between the reference and herein claimed compounds is that the reference has not made all the compounds claimed in herein.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the reference, because they are structurally so similar to those claimed in herein, with the reasonable expectation of achieving a successful pharmaceutical composition, absent evidence to the contrary. Note that the instant claimed compounds are resonating structure.

14. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vennerstrom et al.

Instant claims are directed to a process of preparing quinoneimines of malonamides by ring opening of starting material of formula II of claim 11.

Vennerstrom et al are teaching a similar process of opening of the ring formula similar to claimed in herein. See for example page 435, column 1. The difference between the claimed process and the reference process appears to be the substituent on the ring.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify Vennerstrom process by selecting similar substituents as claimed in herein, because the process per se is an analogous process, with the reasonable expectation of achieving a similar product as claimed in herein, absent evidence to the contrary.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on (571)272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAILENDRA - KUMAR/
Primary Examiner, Art Unit 1621

S. Kumar
3/16/09